



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

KAMOTO, T. et al.

Atty. Ref.: 1114-189; Confirmation No. 6085

Appl. No. 10/665,088

TC/A.U. 1755

Filed: September 22, 2003

Examiner: FAISON, Veronica F.

For: INK COMPOSITION, RECORDING METHOD AND RECORDED IMAGE
UTILIZING THE SAME, INK SET AND INK HEAD

* * * * *

December 18, 2006

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

RULE 181 PETITION

The Commissioner is requested to review the Examiner's restriction requirement in the above stated in the Office Actions of March 29, 2005 and September 21, 2006 for the reasons described below and instruct the Examiner to examine all of the pending claims. At a minimum, the Commissioner is requested to provide a complete statement of the basis for any sustained restriction requirement for clarity of the record.

Specifically, the Commission is requested to review and reverse the restriction requirement and instruct the Examiner to examiner all of the pending claims. The Commission is also requested to review the prosecution of the present application and in particular the Office Action of September 21, 2006 for compliance with the Rules (such as 37 CFR § 1.112) and the MPEP (such as MPEP § 707.07(f)).

The Examiner required restriction in an Office Action dated March 29, 2005, after a first Action on the merits. Specifically, the Office Action dated March 29, 2005 required an election of one of the following Groups of subject matter:

Group I: claims 54-74 and 75-96 "drawn to ink composition"; and

Group II: claims 68, 69, 86-88, 90 and 91 "drawn to recording method".

As noted in the applicants Response of April 7, 2005, to the restriction requirement of March 29, 2005,

claims 54-63, 70-72, 75-85 and 92 are drawn to inks;

claims 64-67 and 86-89 are drawn to methods;

claims 68-69, 73-74, 90-91 and 95-96 are drawn to a recorded image; and

claims 93-94 are drawn to an ink head.

The applicants also elected the subject matter of the Examiner's Group I, with traverse. Basis for the Examiner's inclusion of claims in allegedly separately patentable Groups is not understood.

In the Office Action of March 29, 2005, the Examiner has characterized

claims 54-74 and 75-96 as being "drawn to ink composition" and

claims 68, 69, 90 and 91 as being "drawn to recording method".

The Office Action of March 29, 2006 has not made the restriction requirement FINAL however as the requirement has been made, an election made with traverse, and the Examiner refused to withdrawal the requirement or clarify the record, the applicants believe the present Petition is timely made.

The Examiner stated in the Office Action of September 21, 2006 that claims "71-74, and 93-96, drawn to a print head" as a basis for withdrawal of the claims from

consideration is not understood and correction of the record is requested. Moreover, if the Examiner is intending to withdraw claims to "print head[s]" from consideration then presumably only claims 93 and 94, which define "an ink head", should be withdrawn and the remaining claims examined on the merits.

Moreover, the Examiner's basis for withdrawing the claims (i.e., "non-elected by original presentation") is not understood as previously pending and originally-filed claims 50 and 51 also defined an ink head.

The Commissioner's review of the Examiner's comments and actions in the Office Actions of March 29, 2005 and September 21, 2006, along with an examination of at least claims 54-92 and 95-98 are requested. A Decision on the present Petition prior to the Examiner's next substantive Action is requested as the Decision may effect the scope of examination.

The Commission is further requested to consider the Examiner's maintaining the following art rejections in the Office Action of September 21, 2006 without any comment on the applicants Remarks of December 23, 2004:

the Section 102 rejection of claims 54-58, 60-69, 75, 77-80 and 80-92 over Kato (U.S. Patent No. 6,440,203);

the Section 103 rejection of claims 54-62, 64, 65, 68, 69, 75, "77-34", 86, 87, 90 and 91 over Yatake (U.S. Patent No. 5,746,818); and

the Section 103 rejection of claims 54-62, 64-69, 75-84 and 86-91 over Hayashi (U.S. Patent No. 6,500,248).

Specifically, the Section 102 rejection over Kato stated on pages 4-5 of the Office Action dated September 21, 2006 appears to be the same, verbatim, as the Section 102

rejection over Kato stated on pages 4-5 of the Office Action dated September 23, 2004. The Examiner has not provided any response to the applicants Remarks of December 23, 2004, relating to the rejection as is believed to be required by at least Rule 112 and MPEP § 707.07(f). A new non-final Action on the merits is requested which responds to the applicants previous and present Remarks is requested in the event a rejection over the reference is maintained.

The Examiner had acknowledged in the Office Action of September 23, 2004 that the subject matter of claims 7 and 11 are patentable over Kato. As noted in the Remarks of the Amendment dated December 23, 2004, claim 54, and claims dependent therefrom, have been drafted to include the subject matter of now-canceled claims 11 and 7, respectively, including any intervening claims. Claim 54 is a combination of previous claims 1 and 11, which the Examiner previously indicated as being patentable over Kato. Claims 55-58 and 60-69 are directly or indirectly dependent from claim 54 and should be therefore patentable over Kato. Independent claim 75 is the same as now-canceled claim 35, which the Examiner had previously indicated as being patentable over Kato. See page 4 of the Office Action dated September 23, 2004. Claims 77-80 and 82-92 are directly or indirectly dependent from claim 75 and should be therefore patentable over Kato. The pending claims are submitted to have been recognized by the Examiner to be patentable over Kato.

The Section 103 rejection of claims 54-62, 64, 65, 68, 69, 75, "77-34", 86, 87, 90 and 91 over Yatake stated on pages 6-7 of the Office Action dated September 21, 2006 appears to be the same, verbatim, as the Section 103 rejection of claims 1-10, 15, 16, 19, 20, 26-34, 39-41, 46 and 47 over Yatake stated on pages 6-7 of the Office Action

dated September 23, 2004. The Examiner has not provided any response to the applicants Remarks of December 23, 2004, relating to the rejection as is believed to be required by at least MPEP § 707.07(f). A new non-final Action on the merits is requested which responds to the applicants previous and present Remarks is requested in the event a rejection over the reference is maintained.

Finally, the Section 103 rejection of claims 54-62, 64-69, 75-84 and 86-91 over Hayashi stated on pages 7-8 of the Office Action dated September 21, 2006 appears to be the same, verbatim, as the Section 103 rejection of claims 1-10, 15, 16, 19, 20, 26-34, 39-41, 46 and 47 over Hayashi stated on pages 7-8 of the Office Action dated September 23, 2004. The Examiner has not provided any response to the applicants Remarks of December 23, 2004, relating to the rejection as is believed to be required by at least MPEP § 707.07(f). A new non-final Action on the merits is requested which responds to the applicants previous and present Remarks is requested in the event a rejection over the reference is maintained.

Favorable consideration and a Decision on the present Petition are requested prior to the Examiner's next Action. A fee is not believed to be required for consideration of the present Petition as the Petition is only being submitted due to the failure of the Examiner to clarify the record and/or provide reasonable basis for the restriction requirement. The Commissioner is authorized however by the attached cover letter to charge the undersigned's Deposit Account No. 14-1140 for any fee required for consideration of the present Petition.

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Respectfully submitted,

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